

REMARKS

Claims 3-8 and 11-27 are pending in the application.

Claims 3, 11 and 17-23 are withdrawn from consideration.

Claims 4-8, 12-16 and 24-27 stand rejected.

Claims 4-8, 12-16, 24 and 26 have been amended.

Claims 1-2, 9-10, 22-23 have been cancelled.

Rejection of Claims under 35 U.S.C. §103

Claims 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rappoport, U.S. Patent No. 6,828,963 B1 (Rappoport) in view of Sellers, et al., U.S. Patent 5,311,438 (Sellers). Applicants respectfully traverse this rejection, for at least by reason of the amendments presented below.

While not conceding that the cited references qualify as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully disagree and traverse the rejection as follows. Applicants reserve the right, for example, in a continuing application, to establish that the cited references, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

Further, Applicants respectfully submit that the particular parts of the cited references that the Examiner has relied upon have not been designated as nearly as practicable or applied with the requisite specificity, and the pertinence of each reference has not been clearly explained,

both as required by 37 C.F.R. § 1.104(c)(2). *See also* MPEP § 706.02(j). Nevertheless, the applicants have made every effort to respond to the rejections outlined in the Office Action.

Further still, the rejections put forth in the Office Action are based upon what appear to be something of a jumble of various items within the references. Moreover, no correspondence between these citations and the recited limitation of Applicants' claim are not provided, as is required, and without further support at that. Further, no real relation between the cited items is provided in the Office Action (and, Applicants respectfully submit, such are generally unrelated to one other). Applicants respectfully submit that this results in fundamental inconsistencies, given that the purported combination is simply an assemblage of features that lack a unifying theme. Regardless of the cited features unity, these features clearly have very little to do with Applicant's claim as recited, as will be demonstrated subsequently. As will be appreciated, these steps have been taken in deference to the Examiner, both in an effort to address certain concerns voiced by the Examiner, as well as a genuine effort to move prosecution before the Examiner forward, if for no other reason than the obviously thorough examination accorded the instant application.

In this vein, Applicants respectfully note the amendments made herein. For example, claim 24 now reads as follows:

24. A method in a computing system, the method comprising:
managing a product, comprising
extracting product management information in a first form, wherein
the product management information comprises information regarding the
managing of the product, and

the first form is associated with a first source computerized product management system;
converting the product management information in the first form, wherein
the converting the product management information in the first form
converts the product management information in the first form into
product management information that is in a second intermediate
form; and
converting the product management information in the second intermediate form,
wherein
the converting the product management information in the second
intermediate form converts the product management information in
the second intermediate form into product management
information in a target form,
the product management information in a target form corresponds to a
target computerized product management system, and
the second intermediate form comprises a list of product elements for
defining a hierarchy of data elements.

Claim 26 has been amended in an analogous manner.

As an initial matter, Applicants respectfully note that neither Rappoport nor Sellers, taken alone or in any permissible combination (even taking into consideration the level of skill in the art at the time of invention), fairly show, teach or suggest that the second intermediate form comprises a list of product elements for defining a hierarchy of data elements. In fact, as to claims 24-26, Applicants respectfully submit that this infirmity of the purported combination of Rappoport and Sellers is recognized in the Office Action, given that the claims heretofore including this limitation were not rejected in light of the purported combination of Rappoport and Sellers.

Applicants further respectfully submit that claims 24 and 26, having been amended to recite that "... the product management information comprises information regarding the managing of the product, ..." could not more clearly delineate that the information in question is information regarding the managing of a product, definitively giving patentable weight to the term "product management information." Therefore, the references fail to show, teach or suggest all of the limitations of amended independent claims 24 and 26.

Moreover, Applicants further respectfully submit that there is not even a need to reach the issue of the patentable weight to be accorded the limitation "product management" (a point which, as noted above, Applicants do not concede), the limitation "... a list of product elements ..." is not only a distinguishing feature of the claimed invention, but is also to be accorded patentable weight at least sufficient to allow the claimed invention to distinguish over the purported combination of Rappoport and Sellers.

For the reasons presented above, neither Rappoport nor Sellers, taken alone or in any permissible combination, teach these limitations of amended independent claims 24 and 26.

Claims 4-10 and 12-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rappoport in view of Sellers, and further in view of *PTC: Siebel Systems and PTC create strategic alliance to leverage enriched information across product development, sales and service; Combination of Siebel eBusiness Applications and PTC Collaborative Product Development solutions to deliver competitive advantage*; M2 Presswire; Coventry; Jan 24, 2002 (referred to herein as PTC).

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach

or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

With regard to the first of these criteria, the claims from which claims 4-10 and 12-16 depend are themselves now in allowable condition, as demonstrated in the preceding discussions. As noted above, the Office Action fails to establish the presence of the aforementioned limitations in Rappoport or Sellers, alone or in any permissible combination. As will be appreciated, the burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See* MPEP 706.02(j). Thus, without need of further discussion, Applicants respectfully submit claims 4-10 and 12-16 are allowable for at least the reasons provided in the foregoing regard.

In addition, Applicants also respectfully submit that the Examiner has not satisfied the burden of factually supporting the alleged motivation to combine the two references. The Examiner's duty may not be satisfied by engaging impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). [Applicants respectfully submit that the particular parts of the cited references relied upon by the Examiner and the pertinence of each reference has not been clearly explained, especially with regard to the motivation to combine references in the first full paragraph on page M of the Office Action.] Further, the Office action

does not establish that such a combination of the teachings of these references would meet with success, as required.

As will be appreciated, not even taking the PTC, issues exist with any attempt to combine Rappoport and Sellers. Rappoport is directed to a:

“Computer implemented exchange of data between two distinct computer aided design systems is provided. According to one embodiment, the invention is a computer system for exchanging computer aided design data. In this embodiment, the system includes: a source technical system comprising a source computer aided design data model; a knowledge base comprising a plurality of match data records, the match data records having a source operation region, corresponding to the source technical system, and a target operation region; and an executable computer program. According to one embodiment, the executable computer program is configured to retrieve information corresponding to a feature from the source computer aided design data model; query the plurality of match data records based on the retrieved information; and return information corresponding to a particular match data record in the plurality of match data records, the information representing one or more operations for creating an equivalent feature in a distinct computer aided design model to the feature from the source computer aided design data model. Computer implemented methods for pattern matching are also disclosed.” (Rappoport, Abstract)

Sellers, by contrast, is directed to:

“A manufacturing system utilizes a common database structure and product definition to achieve true integration of multiple systems. The production definition includes an item and specification to define material or resources used in or related to a manufacturing process. The item identifies the material or resources, and the specification describes its performance specifications. Multiple manufacturing systems each utilize the same common database structure and product definition for processing data. These systems may include an Environmental, Health, Safety & Training system to manage environmental and health aspects of the manufacturing process. A New Product Development system may also be integrated with the common database to facilitate and automate the process of developing new products. The true integration of manufacturing systems allows full communication among the systems and automates many functions, such as generating reports and monitoring of hazardous materials and agents.” (Sellers, Abstract)

As can be seen, the references describe solutions of very different problems, and thus provide vastly different functionalities, as well as being used in very different environments. For example, Rappoport addresses a system for the computer implemented exchange of data between two distinct computer aided design (CAD) systems by performing a translation of sorts, to allow . By contrast, Sellers finds application in situations in which a manufacturing system utilizes a common database structure and product definition to achieve true integration of multiple

systems. By definition, Rappoport is directed to providing a means by which two different CAD systems can be allowed to communicate designs between one another. Sellers basis, and stated advantage, is a common database structure and product definition to achieve true integration of multiple systems. These approaches are, by definition, at odds with one another.

By using a common database structure and product definition, Sellers is able to provide cooperative operation between applications through the use of a common database structure and product definition use by all the relevant applications in order to support inter-application interactions. Once again, by contrast, Rappoport approaches application cooperative functioning through the use of translation from a given application's native interactions into the native interactions of another application. These approaches (even philosophies) are plainly two very distinct philosophies on how to support inter-application interactions. To characterize these approaches as being comparable misinterprets the very basis of the thinking behind the approach employed and promoted by each.

Moreover, Rappoport is directed to interactions between CAD systems, allowing Rappoport to gather the requisite features of the item being represented and manipulated thereby, and perform operations on those features that result in features that can then be manipulated by the second system. This is appropriate because Rappoport is directed to providing interoperability between otherwise incompatible CAD systems, which maintain information regarding the item being manipulated in such formats (e.g., the definition of structural features of the item). Sellers, by contrast, is directed to manufacturing systems such as Environmental, Health, Safety & Training system to manage environmental and health aspects of the manufacturing process, a New Product Development system may also be integrated with the common database to facilitate and automate the process of developing new products, and other

such systems. Obviously, Sellers' system has a much wider breadth of application, as Sellers is able to deal with various aspects (or even the entire) manufacturing process. This points up another distinction: Rappoport is focused on the design phase of the product life cycle, while Sellers is focused on the actual manufacturing of a given product. This distinction alone would be sufficient to prevent one of skill in the art to attempt to combine these references, not even taking into consideration the PTC.

Applicants therefore respectfully submit that such an argument fails to establish a *prima facie* case of obviousness and runs perilously close to a forbidden hindsight analysis of the references. The Office Action makes no showing of a motivation to combine Rappoport and Sellers, let alone the PTC, from within the references themselves; therefore, Applicants are left to conclude that it must be presumed that there is none. It is well-established that the best defense to hindsight is a "rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." *See Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be "clear and particular" and "broad conclusive statements about the teaching of multiple references, standing alone, are not 'evidence.'" *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, "leading inventors to look to references relating to possible solutions to that problem."

Ruiz, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field. Nor does the Office Action present any evidence of a problem to be solved from within those references themselves that might be even remotely comparable to that addressed by the present invention.¹ Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teaching of Applicants' own disclosure.

Using Applicants' own disclosure as a blueprint for providing the motivation to combine prior art references in an obviousness determination is impermissible. *See W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

Notwithstanding the forgoing infirmities, were one of skill in the art to forge ahead and attempt to combine the cited references, the resulting system would both fail to operate properly and, were such a system even capable of being made to operate properly, this result would still fail to show, teach or suggest the claimed invention.

First, a fundamental incompatibility of a system that mandates a universal common database structure and product definition is at odds with a system that bases interactions on the translation from one system's representation to another's (even if the systems we in fact

¹ There must be a finding that "there was a disadvantage to the prior systems, such that the 'nature of the problem' will have motivated a person of ordinary skill to combine the prior art references." *Id.* at 666.

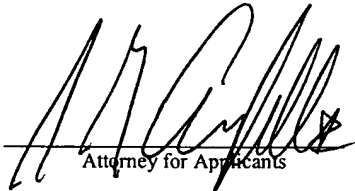
operating in the same phase of a product's lifecycle, which Applicants have respectfully demonstrated is not the case). As would be expected, Sellers finds no need of Rappoport's translation because the systems employing Sellers' techniques (e.g., a common database) have nothing requiring translation. Conversely, in a situation in which two systems did not employ Sellers' techniques (e.g., a common database), Rappoport's would be needed to allow the two systems to interact, and would, by definition, fail to support Sellers' techniques.

For the foregoing reasons, as well as others, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of claims 24 and 26, and all claims dependent upon them, and that they are in condition for allowance. Applicants therefore request the Examiner's reconsideration of the rejections to those claims.

CONCLUSION

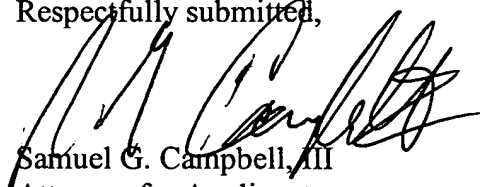
In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5084.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 17, 2006.


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1/17/06
Date of Signature

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